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IN THE
Supreme Court of the United States

KSR INTERNATIONAL CO.,
Petitioner,

v.

TELEFLEX INC. and
TECHNOLOGY HOLDING CO.,
Respondents.

On Petition For Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

MOTION FOR LEAVE TO FILE AMICUS CURIAE BRIEF AND BRIEF OF TWENTY-FOUR INTELLECTUAL PROPERTY LAW PROFESSORS AS *AMICI CURIAE* IN SUPPORT OF PETITIONER

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MOTION FOR LEAVE TO FILE AMICUS BRIEF

Pursuant to Rule 37.3(b) of the Rules of the Supreme Court of the United States, Robert Brauneis, Katherine Strandburg, Margo Bagley, James Bessen, Michael A. Carrier, Rochelle Cooper Dreyfuss, Christine Haight Farley, Cynthia M. Ho, Timothy R. Holbrook, Peter Jaszi, Jay P. Kesan, Mark A. Lemley, Glynn S. Lunney, Jr., Ronald J. Mann, Robert P. Merges, Kimberly A. Moore, Janice M. Mueller, Joseph Scott Miller, Craig A. Nard, Malla Pollack, Arti K. Rai, Pamela Samuelson, Joshua Sarnoff, and John R. Thomas (collectively "Twenty-Four Intellectual Property Law Professors") hereby request leave to file the accompanying *amicus curiae* brief. This brief is submitted in support of the petition for writ of certiorari to the Court of Appeals for the Federal Circuit. Petitioner KSR International Co. has consented to the filing of this brief. Respondents Teleflex Inc. and Technology Holding Co. have not consented.

As set forth in the accompanying brief, the Twenty-Four Intellectual Property Law Professors teach and write about intellectual property at twenty different law schools within the United States, and have a deep interest in the proper interpretation and application of intellectual property law.

The Twenty-Four Intellectual Property Law Professors are greatly concerned that the Federal Circuit's incorrect interpretation of the obviousness standard of Section 103 of the Patent Act, 35 U.S.C. §103, results in unnecessary and socially costly grants of patent rights on obvious extensions of existing technologies. Accordingly, the Twenty-Four Intellectual Property Law Professors respectfully request leave to file the accompanying *amicus curiae* brief.

Respectfully submitted,
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INTEREST OF THE *AMICI CURIAE*

Amici Curiae Robert Brauneis, Katherine Strandburg, Margo Bagley, James Bessen, Michael A. Carrier, Rochelle Cooper Dreyfuss, Christine Haight Farley, Timothy R. Holbrook, Peter Jaszi, Jay P. Kesan, Mark A. Lemley, Glynn S. Lunney, Jr., Ronald J. Mann, Robert P. Merges, Kimberly A. Moore, Janice M. Mueller, Joseph Scott Miller, Craig A. Nard, Malla Pollack, Arti K. Rai, Pamela Samuelson, Joshua Sarnoff and John R. Thomas (collectively "Twenty-Four Intellectual Property Law Professors") respectfully submit this brief in support of petitioner, KSR International Co., encouraging the grant of a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit, because that judgment stems from the application of an obviousness test that is inconsistent with the patent statute, with this Court's precedent, and with good patent policy.[1]

Amici are law professors who teach and write about intellectual property at twenty different law schools within the United States and have an interest in the proper interpretation and application of intellectual property law. *Amici* believe that patent law should provide incentives to search for truly new technological solutions. In contrast, the Federal Circuit's incorrect interpretation of the obviousness standard, as applied in this case, provides incentives for seeking patent rights on obvious extensions of existing technologies. The patenting of obvious extensions of existing technologies has high social costs and is contrary to the Constitutional purpose of the patent system.

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[1] Pursuant to this Court's Rule 37.6, *amici* represent that this brief was not authored in whole or in part by counsel for any party, and that no person or entity other than *amici* and their respective educational institutions has made a monetary contribution to the preparation or submission of this brief. The names of the educational institutions are provided for identification purposes only.

This case provides the Court with an opportunity to overturn the Federal Circuit's much-criticized current approach to non-obviousness, which is at odds with the statutory language, inconsistent with this Court's precedent, and contrary to the goals of the patent system. Unless this Court intervenes, countless applications and issued patents on obvious technologies will continue to burden the U.S. Patent and Trademark Office, the federal courts, and the public at large.

REASONS FOR GRANTING THE WRIT

I. The Federal Circuit's Rule that Patent Obviousness Can Be Shown Only By Producing a "Teaching, Suggestion, or Motivation" to Combine Prior Art Is Contrary to the Approach Mandated by Statute and Inconsistent with this Court's Precedent.

To implement the core patent policy of granting patents only on significant advances in knowledge, Congress chose a standard embodied in Section 103 of the Patent Act, which denies patent protection when "the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. §103. The Court of Appeals for the Federal Circuit has developed a different, and lower, standard. Rather than focus on what the person of ordinary skill in the relevant art would find obvious, the Federal Circuit's test denies a patent only if there is evidence of a specific "suggestion, teaching, or motivation to combine the relevant prior art teachings in the manner claimed." App. at 6a (citing prior Federal Circuit authorities). This "suggestion test" is found neither in the Patent Act nor in this Court's relevant precedent.

To obtain protection under federal patent law, technological developments must meet three substantive requirements, which can be summarized as utility, novelty, and non-obviousness. *See* 35 U.S.C. §§101 (utility), 102 (novelty),

and 103 (non-obviousness). As this Court has recognized, "[b]oth the novelty and the nonobviousness requirements of federal patent law are grounded in the notion that concepts within the public grasp, or those so obvious that they readily could be, are the tools of creation available to all. They provide the baseline of free competition upon which the patent system's incentive to creative effort depends." *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 156 (1989). Because the novelty condition precludes patenting only if a claimed invention is completely anticipated by a single piece of prior art, the requirement of non-obviousness is the sole provision that fully implements the core notion of patent law that patents should be granted only for significant advances over previously known technology. Patents are awarded as "an inducement, to bring forth new knowledge." *Graham v. John Deere Co.*, 383 U.S. 1, 9 (1966). Thus, as articulated by one of the principal drafters of the 1952 Patent Act, only "the unobvious developments which would not occur spontaneously from the application of . . . ordinary skill" are patentable. Giles S. Rich, *The Principles of Patentability*, 42 J. Pat. Off. Soc'y 75, 81-82 (1960). Obvious developments "will be made anyway, without the 'fuel of interest' which the patent system supplies." *Id.* If patents are granted on obvious variations or combinations of what is already known, they needlessly impose the costs of exclusivity on the public.

The standard that Congress chose to implement the policy of requiring a significant advance over existing knowledge is embodied in Section 103 of the Patent Act. That section prohibits the issuance of patents on technological developments for which "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. §103. As explained in the Congressional reports that

accompanied its passage, Section 103 was intended to codify "a condition which exists in the law and has existed for more than 100 years . . . . An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent." *Graham*, 383 U.S. at 14-15, quoting S. Rep. No. 82-1979 (1952) and H. R. Rep. No. 82-1923 (1952). Thus, Section 103 codified previous precedent adopting the practical requirement that the judgment of whether an advance is significant enough to warrant a patent must be made from the perspective of the person of ordinary skill in the art.

Over the past two decades, the Federal Circuit has gradually developed an obviousness test that departs from the statutory mandate to examine obviousness from the perspective of the "person having ordinary skill in the art." The Federal Circuit began to invalidate patents for obviousness only when challengers could present prior art of record that provided a "suggestion or incentive," *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 (Fed. Cir. 1984), "teaching, suggestion or incentive," *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987), "reason, suggestion, or motivation," *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992), or "teaching, suggestion or motivation," *In re Raynes*, 7 F.3d 1037, 1039 (Fed. Cir. 1993), to combine previously existing technologies. This case involves the application of a now-mature "suggestion test" that cannot be found anywhere in Section 103 or in any other part of the Patent Act.

This Court has directly addressed the issue of non-obviousness on several occasions, but none of its discussions give any basis for grafting a "suggestion test" onto the statutory language. *See Graham*, 383 U.S. at 17-18 (laying out the factors underlying the non-obviousness determination); *United States v. Adams*, 383 U.S. 39, 51-52 (1965) (upholding non-obviousness determination based in part on

expert skepticism about the invention); *Anderson's-Black Rock, Inc. v. Pavement Co.*, 396 U.S. 57, 62-63 (1969) (finding obviousness because "to those skilled in the art the use of the old elements in combination was not an invention by the obvious-nonobvious standard"); *Dann v. Commissioner*, 425 U.S. 219, 229-30 (1976) (noting that "[i]n making the determination of 'obviousness,' it is important to remember that the criterion is measured not in terms of what would be obvious to a layman, but rather what would be obvious to one 'reasonably skilled in [the applicable] art'" and holding that "the gap between the prior art and respondent's system is simply not so great as to render the system nonobvious to one reasonably skilled in the art") *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976) (finding claimed invention obvious where the "particular use of the assembly of old elements would be obvious to any person skilled in the art of mechanical application"). Since the Federal Circuit's adoption of its "suggestion test," this Court has not addressed the issue of non-obviousness.

As the Petitioner notes, numerous commentators have observed the inconsistency between the Federal Circuit's test and Supreme Court precedent. *See* Pet. for Cert. at 18-20 (citing authorities). Indeed, in its seminal interpretation of Section 103 of the Patent Act in *Graham*, this Court not only discussed the factors relevant to the determination of obviousness without once mentioning a "suggestion test," it also reversed an appellate court's finding of non-obviousness, despite the appellate court's conclusion that there was "nothing in the prior art suggesting [the] unique combination of these old features" in the claimed invention. *Graham*, 383 U.S. at 30. Thus, it would appear that that the Federal Circuit's "suggestion test" would have led to the opposite result in *Graham* itself.

Because the Federal Circuit's test relegates the "person having ordinary skill in the art" to the sidelines and looks almost entirely to the contents of the prior art references to

demonstrate obviousness, it strays far from the underlying statutory non-obviousness standard. The statutory requirement of non-obviousness is supposed to be separate from and additional to the statutory requirement of novelty. *See, e.g., Graham,* 383 U.S. at 14-15. Rather than focusing on what is *already present* in the prior art, the non-obviousness provision asks whether "the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art," 35 U.S.C. §103, *in light of* all of the prior art. The Federal Circuit's requirement that the prior art *contain* a "suggestion to combine" blurs the distinction between novelty and non-obviousness and fails to follow the statutory mandate that obviousness be judged from the perspective which the "person having ordinary skill in the art" would bring to the prior art as a whole. As Professor Rebecca Eisenberg has noted:

> [The Federal Circuit] has all but ignored the statutory directive that judgments of nonobviousness be made from the perspective of the PHOSITA [person having ordinary skill in the art]. Today, PHOSITA sits on the sidelines of obviousness analysis. Courts consult PHOSITA on the scope, content, and meaning of prior art references but not on the ultimate question of whether the invention would have been obvious at the time it was made in light of the prior art.

Rebecca Eisenberg, *Obvious to Whom? Evaluating Inventions from the Perspective of PHOSITA*, 19 Berkeley Tech. L.J. 885, 888 (2004).

Although the Federal Circuit purports to recognize that suggestions to combine existing elements may be "implicit," *see, e.g., In re Kotzab,* 217 F.3d 1365, 1370 (Fed. Cir. 2000), its application of the standard for "implicit" suggestions continues to read the person having ordinary skill in the art or "PHOSITA" out of the obviousness inquiry. Explicit or implicit suggestions to combine may be found, according to the Federal Circuit: "1) in the prior art references them-

selves; 2) in the knowledge of those of ordinary skill in the art that certain references . . . are of special interest or importance in the field; or 3) from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem." App. at 6a (citations omitted). The first option focuses entirely on what is in the prior art references. The second limits the PHOSITA to the role of a sort of reference librarian, assisting in locating appropriate prior art references but apparently incapable of applying them in light of his or her knowledge and skill.

At first glance, the third option — the "nature of the problem to be solved" — might appear to invoke the judgment of the PHOSITA as to obviousness. Again, however, the focus is on the prior art references; the nature of the problem serves only to motivate a search for references relating to the problem at hand. Indeed, the Federal Circuit's analysis in this case exemplifies the short shrift given to the person of ordinary skill in the art by this approach. Here, the District Court based its finding of a sufficient suggestion or motivation to combine references in part on the "nature of the problem to be solved." App. at 42a-43a. Nonetheless, the Federal Circuit rejected the District Court's findings because, as applied by the Federal Circuit, the "nature of the problem to be solved" provides a cognizable motivation to combine references only when "two prior art references address the precise problem that the patentee was trying to solve." App. at 12a. In this instance, the problems addressed by the references did not track the specifics of the patent at issue quite precisely enough. App. at 12a-13a. Despite lip service to the question whether the nature of the problem would have "led a person of ordinary skill in the art to combine the prior art teachings in the particular manner claimed," App. at 12a, the court's analysis in fact paid no attention to how such a person would have viewed the prior art references in light of the problem the *patentee* was trying to solve. Instead, the Federal Circuit focused entirely on whether the problem

addressed in the references was precisely the same as the problem addressed by the patent in suit. App. at 12a-13a. There is apparently no room for the possibility that a person of ordinary skill in the art might find it obvious to apply prior art technology to a problem slightly different from the problem articulated in the prior art reference.

While the "suggestion test" thus marginalizes the PHOSITA in obviousness determinations in litigation, it ensures that the PHOSITA has even less impact at the Patent and Trademark Office. Federal Circuit precedent makes clear that patent examiners cannot rely on common knowledge in the art or on their own technical knowledge in the art as a basis for rejecting patent applications. *See, e.g., In re Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002) ("'Common knowledge and common sense,' even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.") (citation omitted). As a result, the Federal Circuit has forbidden the Patent and Trademark Office to deny a patent based on common knowledge in the art without pointing to specific evidence of a teaching, suggestion or motivation to combine the particular existing references.

Because the Patent and Trademark Office has limited ability in the context of an *ex parte* examination proceeding to collect evidence beyond what it can find in the written prior art, the Federal Circuit's approach severely limits the Patent and Trademark Office's ability to take into account the common knowledge of those in the art. *See* Arti K. Rai, *Allocating Power over Fact-Finding in the Patent System*, 19 Berkeley Tech. L. J. 907, 912-17 (2004) (making this point and arguing that the Federal Circuit's approach to examiner technical knowledge may be inconsistent with this Court's mandate of deference to agency factfinding as articulated in *Dickinson v. Zurko*, 527 U.S. 150 (1999)). By hobbling the Patent and Trademark Office in this way, the Federal Circuit has subverted this Court's command "that the primary

responsibility for sifting out unpatentable material lies in the Patent Office." *Graham*, 383 U.S. at 18. The inability of the Patent and Trademark Office to weed out obvious patents under the Federal Circuit's suggestion test is extremely serious for the health of the patent system, since, as this Court has recognized, "[t]o await litigation is — for all practical purposes — to debilitate the patent system." *Id.*

The Federal Trade Commission has also recognized the difficulties for a competitive economy that are posed by an inadequate standard of obviousness:

> Inventive processes typically involve judgment, experience, and common sense capable of connecting some dots. The suggestion test, rigidly applied, assumes away a PHOSITA's typical levels of creativity and insight and supports findings of nonobviousness even when only a modicum of additional insight is needed. . . . The *presence* of 'specific and definitive art references with clear motivation of how to combine those references' may confirm the obviousness of an invention. In contrast, the *absence* of such prior art references does not provide any evidence about whether a PHOSITA could have combined prior art references to achieve the invention, given the typical level of insight in that field.

Federal Trade Commission, *To Promote Innovation: The Proper Balance of Competition and Patent Law and Policy* (Oct. 2003), Chap. 4, at 14. (Emphasis added.)

In sum, the Federal Circuit's obviousness test all but requires both the Patent and Trademark Office and the courts to base their analyses on documentary evidence of obviousness which will often be unavailable both to the Patent and Trademark Office and to the courts. The test will thus allow patents to issue in many cases where combining pre-existing technologies would have been an obvious step for a person having ordinary skill in the art.

II. The Federal Circuit's "Suggestion Test" Sets Bad Patent Policy

The low standard for patentability that results from application of the "suggestion test" leads inevitably to the grant of patent rights to combinations of existing technological knowledge for which no patent incentive was needed. Such patents not only do not "promote the Progress of . . . useful Arts," *see* U.S. Const., art. I, §8, cl. 8, they have pernicious social effects. *Amici* are convinced that the "suggestion test" results in the issuance and enforcement of many such patents that should be declared invalid as obvious. *See, e.g.*, Glynn S. Lunney, Jr., *E-Obviousness*, 7 Mich. Telecomm. Tech. L. Rev. 363, 370-379 (2000) (presenting a statistical study showing a drop in Federal Circuit patent invalidations for obviousness, and identifying the Circuit's "suggestion" test as one of the causes).

The unnecessary patents resulting from the Federal Circuit's test lead to higher direct costs to consumers and higher transaction costs associated with the need to negotiate permission from additional patent owners in order to bring obvious combination technologies to market. The issuance of suspect patents also increases the litigation burden on the federal courts.

In addition, the availability of patents on obvious combinations overwhelms the Patent and Trademark Office with applications for patents on obvious combinations of previously existing technologies; promotes socially wasteful races to patent these obvious advances; and raises patent search costs for those seeking to combine existing technologies. Moreover, in attempting to find documentation of what is commonly known in the art, patent examiners and later litigants must waste time and resources searching for specific articulations of common, but largely tacit, knowledge.

Patent examiners and after-grant challengers will often be unable to find a specific "suggestion, teaching, or motivation" for a particular combination of existing elements, even if that combination is not innovative. In many cases, it would be so natural for a person of ordinary skill in the art to use two existing elements together in appropriate circumstances that no one would think of articulating explicitly the kind of "suggestion, teaching, or motivation" that the Federal Circuit requires. "Trained scientists, engineers and other practitioners are seldom so dull-witted as to unvaryingly require the specific, step-by-step combination of elements from the prior art." John R. Thomas, *Formalism at the Federal Circuit,* 52 Am. L. Rev. 771, 802 (2003).

Moreover, many aspects of ordinary skill in a technological art are not likely to find their way into a written record, either because such tacit knowledge is not amenable to verbal description or because practitioners are motivated to publish novel applications of their arts, not routine applications. *See* National Research Council, *A Patent System for the 21st Century* 90 (2004) ("[S]cientists, artisans, and creative people generally speaking strive to publish non-obvious information. So if it is obvious to those of skill in the art to combine references, it is unlikely that they will publish such information.") As Professor Eisenberg has noted, "[a]ctive practitioners of a technology bring more to a problem than may be found in written prior art, including training, judgment, intuition, and tacit knowledge acquired through field experience. Scientific and technological work involve the application of craft skills that are familiar to practitioners but defy explicit articulation." Eisenberg, *supra*, at 897-98, *citing* Jerome R. Ravetz, *Scientific Knowledge and its Social Problems* 75-76 (1971).

Obvious combination patents are particularly likely to issue in fast-moving technological areas in which the written prior art is unlikely to contain up-to-date expositions of obvious applications of new technologies. For example, every new

recording format – from cassette tapes to Compact Discs, Digital Versatile Discs, Mini Discs, and solid state storage – might present an opportunity for someone to claim "the combination" of a microphone with this new technology to enable the recording of sound waves in the air. When a new recording technology is first announced, no one will have yet articulated a specific "suggestion, teaching, or motivation" to combine it with a microphone, precisely because that particular technology is new. Yet that should not mean that the first person to articulate that combination in a patent application should get exclusive rights to the combination for 20 years.

Similarly, technological advances have given rise to numerous opportunities to computerize existing processes, many of which would likely have been obvious to those skilled in the art once the computer technology became available. A related problem of obvious applications of new technologies has also been noted in the biotechnology arena, where many have argued that methodological advances provided an obvious path to new results that should not themselves have been patentable. As Professors Dan L. Burk and Mark Lemley remark, "the Federal Circuit has bent over backwards to find biotechnological inventions nonobvious, even if the prior art demonstrates a clear plan for producing the invention." *Is Patent Law Technology-Specific?*, 17 Berkeley Tech. L.J. 1155, 1156 (2002).

Technological advances and expansive interpretations of the scope of patentable subject matter have also resulted in patents being issued in areas, such as software and business method patents, in which the common knowledge of the art has not traditionally been documented in easily accessible forms such as patents and academic publications. The Federal Circuit's emphasis on documentation of what is widely known in the art is particularly problematic for patenting in these areas. *See, e.g.*, Margo A. Bagley, *E-Commerce and Equivalence: Defining the Proper Scope of Internet Patents*, 7 Mich. Telecomm. & Tech. L. Rev. 253,

279-80 (2000-2001) (discussing the limited availability of documentary prior art in the areas of business methods and software).

The overpatenting that results from the Federal Circuit's "suggestion test" creates an unnecessary drag on innovation through higher prices to consumers and transaction costs associated with licensing and enforcing these unnecessary patents. Anyone who wants to use the combination of technologies will have to negotiate permission from and pay royalties not only to the owners of any patents on the individual elements, but also to the owner of the patent in the combination. The costs of patents that are unnecessary to promote innovation also include "the benefits lost when a course of research is foregone out of fear that a product cannot be produced without obtaining a license that may be unavailable. Even when a product is produced, there may be costs in restructuring a research program to design around existing patents." John H. Barton, *Non-Obviousness*, 43 IDEA 475, 494 (2003). When two or more parties can block the practical application of technology, the difficulty and social cost of developing that practical application increases significantly, raising the likelihood of "patent thickets." *See, e.g.*, Carl Shapiro, *Navigating the Patent Thicket: Cross Licensing, Patent Pools, and Standard Setting*, in *Innovation Policy and the Economy* (Adam Jaffe et al., eds., 2001); *see also* Michael A. Heller & Rebecca S. Eisenberg, *Can Patents Deter Innovation? The Anticommons in Biomedical Research*, Science, May 1, 1998, at 698-99.

In addition, anyone interested in combining any existing technologies must expend resources searching for possible patents on such combinations, whether or not such patents have issued. The low threshold of non-obviousness for combination patents also provides incentives to invest in socially wasteful efforts to patent run-of-the-mill combinations of previously known technologies. *See, e.g.*, Bronwyn H. Hall and Dietmar Harhoff, *Post-Grant Reviews in the U.S.*

Patent System — Design Choices and Expected Impact, 19 Berkeley Tech. L.J. 989, 992-1000 (2004) (discussing potential problems caused by low quality patents, presenting evidence of issuance of lower quality patents by U.S. Patent and Trademark Office, and relating the issuance of lower quality patents to the "suggestion" test for obviousness); Robert P. Merges, *Uncertainty and the Standard of Patentability*, 7 High Tech. L. J. 1, 19 (1993) (arguing that the non-obviousness standard should be high enough to motivate research in areas in which results are uncertain). In addition, it motivates true innovators to divert some of their resources towards identifying and claiming all possible combinations of their new technologies with existing technologies, to prevent others from getting patents that would block important and obvious applications of their technologies.

The Federal Circuit has explained its requirement of a specific "teaching, suggestion, or motivation" to combine by noting in a number of cases that a "rigorous application" of such a requirement is the best way to avoid the potential distortions of hindsight. App. at 6a-7a; *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d. 994, 999 (Fed. Cir. 1999). Although *amici* do not deny the potential for hindsight bias, *amici* believe that the Federal Circuit's suggestion test simply does not solve the hindsight bias. Rather than capture the actual knowledge of those of skill in the art at the time a claimed combination of existing technology was made, it introduces its own hindsight bias, suggesting that skilled artisans should somehow have thought to articulate each obvious possibility in prior art references. This assumption simply does not reflect reality.

In sum, the predictable result of the availability of patents on obvious combinations of existing elements is that it becomes more difficult to bring the benefits of technology to society, thus undermining the ultimate goal of patent law.

III. This Case is an Excellent Vehicle for Addressing the Conflict Between this Court's Precedent and the Federal Circuit's "Suggestion Test."

The Federal Circuit has fully developed its rule that combinations of existing elements are nonobvious, and therefore patentable, unless some specific "teaching, suggestion, or motivation" to combine those elements is found in the prior art. Every active Federal Circuit judge has been a member of a panel that applied that rule in a decided case.[2] The Federal Circuit's decision not to publish the opinion in the instant case, resolving an appeal from a fully-reasoned, published District Court decision, is also a signal that the judges in that Circuit believe that the "teaching, suggestion, or motivation" requirement is settled law, and that its application should proceed as a matter of course. There is thus little possibility that the Federal Circuit will correct its position without this Court's intervention.

This case is an excellent vehicle for deciding whether the Federal Circuit's obviousness test is in accord with the Patent Act and with the Constitutional basis for the patent system. The case involves simple technologies; it is procedurally clean and ripe; and counsel on both sides are experienced and knowledgeable.

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[2] *See, e.g.*, App. 1a (Judges Mayer, Schall, and Prost); *Vulcan Engineering Co., Inc. v. Fata Aluminium, Inc.*, 278 F.3d 1366 (Fed. Cir. 2002) (Judges Newman, Michel, and Lourie); *In re Sang Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (Judges Newman, Clevenger, and Dyk); *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385 (Fed. Cir. 2001) (Judges Newman, Michel, and Plager); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000) (Judges Clevenger, Bryson, and Linn); *Winner International Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 (Fed. Cir. 2000) (Judges Michel, Rader, and Gajarsa); *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (Judges Mayer, Michel, and Clevenger); *C.R. Bard, Inc. v. M3 Systems*, 157 F.3d 1340, 1352 (Fed. Cir. 1998) (Judges Mayer, Newman, and Bryson); *Pro-Mold and Tool Co., Inc. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996) (Judges Plager, Lourie and Rader).

There are two simple technologies at issue in this case. Both relate to an automobile driver's control of engine speed. One is an adjustable gas pedal. Such a pedal can be positioned so that it is closer or farther away from the driver's seat, accommodating shorter or taller drivers. The other is an electronic gas pedal position sensor. It senses the position of the gas pedal and reports that position by means of an electronic signal to a computer in the car, which then adjusts fuel and air flow to the car's engine. This electronic throttle control system replaces the older technique of mechanically linking the gas pedal directly to the carburetor.

Respondents do not claim to have invented either the adjustable gas pedal or the electronic gas pedal position sensor. Rather, they claim – in claim 4 of U.S. Patent No 6,237,565, the claim at issue in this litigation – to have invented, and to be entitled to exclusive patent rights to, the use of the combination of a particular prior art adjustable gas pedal together with an (also prior art) electronic gas pedal position sensor. Thus, this case presents a clear and simple example of a patent combining prior art elements, which this Court can use to consider the proper nonobviousness standards to apply to such patents without being distracted by arguments about complicated technologies.

The procedural stance in which this case reaches this Court fully supports an examination of the question presented in the petition for writ of certiorari. There can be no doubt that the issue was preserved. Petitioner urged both the District Court and the Federal Circuit to apply the nonobviousness standards articulated in this Court's relevant precedents. Both courts declined to do so. Although neither court's opinion contains a discussion of this rejection of Supreme Court precedent, the lack of discussion is simply an acknowledgement that the Federal Circuit has irrevocably committed itself to that rejection, and has fully developed an alternative test.

The facts in this case that are relevant to the question presented have also been sufficiently developed. The patent claim at issue in this case, and the relevant prior art patents, have been thoroughly explored by both the District Court and the Federal Circuit. There are no ambiguities that would be cleared up by further factual development. The legal issue here is ready to be decided by this Court.

Finally, counsel for both parties in this case are knowledgeable and experienced. James W. Dabney of Fried Frank Harris Shriver & Jacobson LLP, counsel of record for petitioner, is a seasoned patent litigator whose previous experience includes serving as the successful counsel of record for petitioner in *Holmes Group, Inc. v. Vornado Air Circulations Sys., Inc.*, 535 U.S. 826 (2002). John F. Duffy, of counsel for petitioner, is a law professor and former Supreme Court clerk who has co-authored a leading casebook on patent law, *see* Robert Patrick Merges & John Fitzgerald Duffy, *Patent Law and Policy: Cases and Materials* (3d ed. 2002), and who has written broadly on patent law issues, *see, e.g.*, John F. Duffy, *Rethinking the Prospect Theory of Patents*, 71 U. Chi. L. Rev. 439 (2004); John F. Duffy, *Harmony and Diversity in Global Patent Law*, 17 Berkeley Tech. L. J. 685 (2002); John F. Duffy, *The Festo Decision and the Return of the Supreme Court to the Bar of Patents*, 2002 Sup. Ct. Rev. 273; John F. Duffy, *On Improving the Legal Process of Claim Construction: Administrative Alternatives*, 2 Wash U. J. L. & Pol'y 109 (2000).

Counsel for respondents, successful appellants below, are also experienced litigators who have previous experience in appellate patent litigation in cases such as *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313 (Fed. Cir. 2002), and additional appellate litigation experience in cases such as *Miltimore Sales, Inc. v. International Rectifier, Inc.*, 119 Fed. Appx. 697 (6th Cir. 2004). Both parties would be well represented in this Court.

In sum, the question presented in this case raises an important and timely issue of federal patent law. This case is the perfect vehicle for considering it.

CONCLUSION

For the foregoing reasons, the petition for writ of certiorari should be granted.

Respectfully submitted,

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